

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

NAPOLI et al.

Art Unit: 2712

Serial No.: 09/012,144

Examiner: Nguyen, L.

Filed: January 22, 1998

For: ELECTRONIC CAMERA WITH QUICK VIEW AND QUICK ERASE FEATURES

Certificate of Mailing

I hereby certify that this paper is being deposited with the  
United States Postal Service as first class mail in an  
envelope addressed to: Assistant Commissioner for  
Patents, Washington, D.C. 20231 on:

Date: 03/01/01

By: Marc A. Rossi

Marc A. Rossi

BRIEF ON APPEAL

RECEIVED  
APR 2 2002  
OFFICE OF PETITIONS

ROSSI & ASSOCIATES  
P.O. Box 826  
Ashburn, VA 20146-0826

## TABLE OF CONTENTS

I.	REAL PARTY OF INTEREST .....	1
II.	RELATED APPEALS AND INTERFERENCES .....	1
III.	STATUS OF CLAIMS ON APPEAL .....	1
IV.	STATUS OF AMENDMENTS AFTER FINAL REJECTION .....	2
V.	SUMMARY OF THE INVENTION .....	2
VI.	ISSUES ON APPEAL .....	3
VII.	GROUPING OF CLAIMS .....	3
VIII.	ARGUMENT .....	4
IX.	CONCLUSION .....	9
X.	CLAIM APPENDIX .....	10

## TABLE OF AUTHORITIES

<u>In re Bell</u> , 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) .....	7
<u>In re Fine</u> , 837 F.2d 1071, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) .....	7
<u>In re Kotzab</u> , 55 USPQ2d 1313, 1316-1317 (Fed. Cir. 2000) .....	7
<u>In re Oetiker</u> , 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) .....	7
<u>In re Vaeck</u> , 947 F.2d 488, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991) .....	6
<u>Lindemann Maschinenfabrik GMBH v. American Hoist &amp; Derrick Co.</u> , 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) .....	4
<u>Radio Steel &amp; Mfg. Co. v. MTD Products, Inc.</u> , 731 F.2d 840, 221 USPQ 657, 661 (Fed. Cir. 1984), <u>cert denied</u> , 469 U.S. 831 (1984) .....	4
<u>Structural Rubber Prod. Co. v. Park Rubber Co.</u> , 749 F.2d 707, 223 USPQ 1264, 1270 (Fed. Cir. 1984) .....	4

### I. REAL PARTY OF INTEREST

The real party of interest in the present application is the Eastman Kodak Company, 343 State Street, Rochester, New York 14650-2201.

### II. RELATED APPEALS AND INTERFERENCES

There are presently no appeals or interferences that would directly affect or be directly affected by or have a bearing on the Board's decision in the present appeal.

### III. STATUS OF CLAIMS ON APPEAL

The present application was filed on January 22, 1998 with claims 1-15. An Official Action was mailed July 12, 1999 rejecting claim 4 under 35 U.S.C. § 112, rejecting claims 5, 6, 9, and 11-13 under 35 U.S.C. § 102(e) as being anticipated by Fellegara et al. (U.S. Patent No. 5,845,177), rejecting claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over Fellegara et al. in view of Nagano (U.S. Patent No. 5,561,462), and rejecting claims 7-8, 10, and 14-15 under 35 U.S.C. § 103(a) as being unpatentable over Fellegara et al. An amendment was filed in response to the Official Action on December 13, 1999, amending claims 1, 4, 5, 9, 12, 13 and canceling claim 11. A Final Official Action was mailed on March 1, 2000 rejecting claims 5, 6, 9, and 12-13 under 35 U.S.C. § 102(e) as being anticipated by Fellegara et al., rejecting claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over Fellegara et al. in view of Nagano (U.S. Patent No. 5,561,462), and rejecting claims 7-8, 10, and 14-15 under 35 U.S.C. § 103(a) as being unpatentable over Fellegara et al.

#### IV. STATUS OF AMENDMENTS AFTER FINAL REJECTION

An After Final Amendment and Request for Reconsideration and a Notice of Appeal with Petition for Extension of Time were filed on September 1, 2000. Entry of the amendment was denied in the Advisory Action dated September 19, 2000. Claims 1-10 and 12-15 remain pending and the subject of this appeal. Claims 1-10 and 12-15 are set forth in the Claims Appendix.

#### V. SUMMARY OF THE INVENTION

The invention is directed to an electronic camera which includes a visual viewfinder, a sensor for capturing an image, a first buffer memory for storing the captured image, an image processor for generating a processed image file, a second memory for storing the processed image file, an electronic image display for reviewing the captured image, and a quick view feature. The quick view feature is embodied in a control section for powering up the image display after the image is captured in order to review the captured image, and then automatically turning off the image display after the image review period has elapsed.

The quick view feature reduces battery drain. When this feature is enabled, the LCD display is turned on immediately after each picture is taken, typically for about three seconds, and then turned off. This allows the user to verify that an acceptable image was taken. If so, the user waits until the processing is completed and the next image can then be taken. Thus, the LCD display remains off most of the time to reduce battery drain, without requiring the user to manually turn it on and off.

In a further embodiment, the user interface of the camera further provides a quick erase feature in which the processor responds to the quick erase command by terminating the processing of the image file and deleting the partially completed image file from the second memory. The quick erase command also reduces battery drain and enhances the user's convenience. When displaying a newly taken image, the LCD display includes a quick erase icon. If the user does not want to keep a new image, a quick erase key is pressed. This immediately stops the current image from being processed. As a result, the camera does not waste battery power by creating and storing an image file that will be immediately deleted. In addition, a new image can be taken immediately, rather than waiting five to ten seconds for the processing to be completed and potentially losing a picture opportunity during the ensuing wait.

## VI. ISSUES ON APPEAL

- A. Is the rejection of claims 5, 6, 9 and 12-13 under 35 U.S.C. § 102(e) as being anticipated by Fellegara et al. proper.
- B. Is the rejection of claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over Fellegara et al. in view of Nagano proper.
- C. Is the rejection of claims 7-8, 10 and 14-15 under 35 U.S.C. § 103(a) as being unpatentable over Fellegara et al. proper.

## VII. GROUPING OF CLAIMS

For the limited purposes of this appeal, claims 5, 6, 12 and 13 will be grouped together, a separate argument will be presented with respect to claim 9, 1-4 will be grouped together, claims 7 and 14 will be grouped together, and claims 8, 10 and 14 will be grouped together.

## VIII. ARGUMENT

A. Is the rejection of claims 5, 6, 9 and 12-13 under 35 U.S.C. § 102(e) as being anticipated by Fellegara et al. proper.

Claims 5, 6, 9 and 12-13 stand rejected under 35 U.S.C. §102(b) which states:

A person shall be entitled to a patent... unless the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States...

The novelty of a claimed invention is tested under 35 U.S.C. §102(b) by determining whether or not the claimed invention is fully anticipated by the prior art. Anticipation must be established by the disclosure in a single reference of every element of the claimed invention in question. See Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984); Radio Steel & Mfg. Co. v. MTD Products, Inc., 731 F.2d 840, 221 USPQ 657, 661 (Fed. Cir. 1984), cert denied, 469 U.S. 831 (1984); and Structural Rubber Prod. Co. v. Park Rubber Co., 749 F.2d 707, 223 USPQ 1264, 1270 (Fed. Cir. 1984).

Independent claims 5, 9 and 13 includes a quick view feature that is not described in the prior art relied upon in the rejection. The quick view feature is a power saving camera mode in which the electronic display for review of a captured image is automatically turned on for a period of time after the image is captured and then automatically turned off. Claim 5, for example, calls for a user interface for selectively enabling a quick view feature in which the image display is automatically turned on after an image is captured, claim 9 calls for an electronic image display that displays captured images from a first memory for a first time interval after the shutter button is operated, and claim 13 calls for selectively enabling a quick view feature in which the image display is

automatically turned on in response to actuation of the shutter button for a period of time after the image is captured.

Appellants submit that the Examiner's own remarks illustrate that Fellegara et al. does not disclose the claimed invention. The Examiner states that Fellegara et al. discloses a “shutter button 24 which causes the camera controller 68 to initiate a power up mode to perform the pre-exposure operation (column 11, lines 20-31).” See, Final Official Action, page 2, paragraph 3, lines. 8-10. The power up mode described in Fellegara et al., however, does not refer to a power up of the image review display. Instead, pre-exposure operations are described as auto focusing and exposure control operations (column 11, lines 14-16). As the Examiner correctly notes, the initiation of the display to review a captured image on the display unit 36 only occurs upon manual activation of the quick review switch 37. Further, Fellegara et al. specifically states that the main screen display unit 36 is not activated unless specifically turned on by the camera operator using the review switch 37 (column 13, lines 7-15).

By the Examiner's own analysis, Fellegara et al. fails to disclose an image display controller responsive to actuation of the shutter button for automatically powering up the image display after the image is captured in order to review the captured image. Fellegara et al. actually teaches away from the claimed invention by requiring the manual operation of the review switch 37 to view a captured image. Accordingly, Fellegara et al. cannot anticipate claims 5, 9 and 13 and claims dependent thereon under 35 U.S.C. § 102.

Still further, claim 9 calls for a user enabled control section coupled to the processor for erasing an image before the end of a second time interval so as to facilitate the capture and



processing of another image, wherein the second time interval is the time period utilized by the processor to process an image. The Examiner has failed to specifically point out where Fellegara et al. discloses the erasing of an image before the end of a second time interval as set forth in claim 9. Absent such a showing the rejection is improper and should be withdrawn.

B. Is the rejection of claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over Fellegara et al. in view of Nagano proper.

Claims 1-4 stand rejected as being unpatentable under 35 U.S.C. § 103 which states in part:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to one of ordinary skill in the art to which said subject matter pertains...

A proper analysis in determining whether claimed subject matter is obvious in view of a combination of prior art references under 35 U.S.C. § 103 requires consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed device or carry out the claimed process, and (2) whether the prior art would also have revealed that in so making the claimed device or carrying out the claimed process, those of ordinary skill would have a reasonable expectation of success. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). “[T]o establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. . . . The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. . . . In addition, the teaching,

motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references." In re Kotzab, 55 USPQ2d 1313, 1316-1317 (Fed. Cir. 2000).

In rejecting claims under 35 U.S.C. § 103, the PTO bears the initial burden of presenting a prima facie case of obviousness. In re Oetiker, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The Federal Circuit has clearly articulated that a prima facie case of obviousness "is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). Here, in an attempt to meet that burden, it is the appellants position the Examiner has improperly relied upon the teachings of appellants own disclosure to suggest the combination of elements set forth in the claims at issue. As the Federal Circuit has stated, "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Appellants note that claim 1 also discloses a quick view feature in which the display is automatically activated. The Examiner specifically states that Fellegara et al. "does not teach a display that is automatically turned on without user intervention. Instead, the display unit is not activated unless specifically turned on by the user." See, Final Official Action, last line of page 7 through line 2 of page 8. Appellants note the Examiner's statement further confirms appellants position that Fellegara et al. fails to disclose automatic activation of the display with respect to the anticipation rejection discussed above.

The Examiner states that in Nagano "it is inherent that the [electronic viewfinder] is automatically turned on, without user intervention". The Examiner then opines that it would be obvious to modify Fellegara et al. in view of Nagano to provide automatic activation.

Appellants first note that an argument that something is "inherent" is inappropriate with respect to a rejection under 35 U.S.C. § 103. The standard is not what is "inherent", but what would be suggested to one of ordinary skill in the art from the teachings of the reference. In the claimed invention, an optical viewfinder is used for viewfinding, and the image display is activated in the quick view feature to allow review of the image after capture has taken place. The operation of the electronic viewfinder of Nagano is not even relevant with respect to automatically activating a quick view feature in response to activation of the shutter button.

In view of the above, the combination of references proposed by the Examiner, would not form the basis for finding the claims prima facie obvious under 35 U.S.C. § 103, as neither reference taken singly or in combination discloses the quick view feature as claimed.

C. Is the rejection of claims 7-8, 10 and 14-15 under 35 U.S.C. § 103(a) as being unpatentable over Fellegara et al. proper.

Claims 7 and 14 claim a quick erase feature that enables a user to immediately erase an unwanted image prior to completion of image processing. Claim 7, for example, calls for a processing section that erases the captured image prior to completion of the image processing. Similarly, claim 14 is directed to a method wherein the captured image is erased prior to completion of the processing. As a result, the camera may capture another image immediately without delay.

Claims 8, 10 and 15 further require that a partially processed image file be deleted in response to the erase command.

The Examiner admits that Fellegara et al. does not explicitly teach a processing section that responds to a command by terminating image processing and erasing the incomplete processed

image from the second memory. The Examiner states, however, that it would be obvious to modify Fellegara et al. to meet the limitations set forth in the claims at issue.

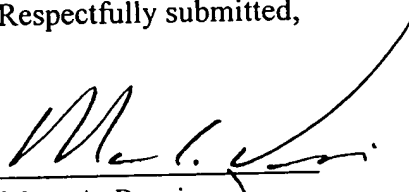
Appellants submit there is nothing in Fellegara et al. to suggest the feature set forth in claims 7 and 14 wherein the captured image is erased prior to the completion of image processing. Further, appellants submit there is nothing in Fellegara et al. to suggest a partially processed image file be deleted as required in claims 8, 10 and 15. Instead, appellants believe the Examiner is relying on appellants own disclosure to provide the motivation for modifying Fellegara et al. to meet the claim limitations. Accordingly, the Examiner has failed to establish a prima facie case of obviousness as required under 35 U.S.C. § 103.

#### IX. CONCLUSION

For at least the foregoing reasons, appellants' presently claimed invention as set forth in claims 5, 6, 9, and 12-13 is not anticipated under 35 U.S.C. § 102. Further, appellants' presently claimed invention as set forth in claims 1-4, 7-8, 10, and 14-15 would not have been obvious to one of ordinary skill in the art under 35 U.S.C. § 103. Accordingly, appellants respectfully request that the final rejection of the claims be reversed and the application passed to issuance.

Respectfully submitted,

03/01/01  
Date

  
Marc A. Rossi  
Registration No. 31,923

Attorney Docket: 77140PRC - KODA; 267  
ROSSI & ASSOCIATES  
P.O. Box 826  
Ashburn, VA 20146-0826  
703-904-4332

## X. CLAIM APPENDIX

1. (Once Amended) An electronic camera for capturing and displaying one or more images, said camera comprising:

an optical viewfinder for composing an image prior to image capture;

a sensor for capturing the composed image;

an actuatable shutter button effective when actuating for permitting the sensor to capture the image;

an electronic image display for displaying the captured image; and

a quick view feature in which the image display is automatically turned on in response to actuation of the shutter button, without user intervention, for a period of time after an image is captured, and then automatically turned off, said quick view feature including a control section for automatically powering up the image display after the image is captured by the sensor in order to display the captured image, and then automatically turning off the image display after the period has elapsed.

2. A camera as claimed in claim 1 further including a memory section for storing the captured image.

3. A camera as claimed in claim 2 wherein the memory section includes a buffer memory for storing the captured image in order that it may be quickly displayed by the image display during an initial review and an output memory for storing the captured image after it has been judged to be acceptable during the initial review.

4. (Once Amended) The camera as claimed in claim 3 wherein the camera includes a processing section for operating on the captured image in order to store the captured image in the output memory and a user interface provides an erase command to the processing section to erase the captured image.

5. (Once Amended) An electronic still camera for capturing and displaying images, said camera comprising:

- an optical viewfinder for composing images prior to capture;

- a sensor for capturing an image;

- a first buffer memory for storing the captured image;

- an electronic image display for displaying the captured image stored in the buffer memory;

- a processing section for performing image processing on the captured image over a period of time and generating a processed image file therefrom, said processing section further responsive to an erase command in order to erase the captured image;

- a second memory for storing the processed image file;

- a user interface for selectively enabling a quick view feature in which the image display is automatically turned on after an image is captured, the user interface including an actuatable shutter button effective when actuating for permitting the image sensor to capture the image;

- an image display controller responsive to actuation of the shutter button for automatically powering up the image display after the image is captured in order to display the captured image stored in the first buffer memory; and

said user interface further providing the erase command to the processing section, which thereupon erases the captured image.

6. The camera as claimed in claim 5 wherein the image display controller automatically powers up the image display for a predetermined period after the image is captured by the sensor in order to display the captured image stored in the first buffer memory, and then automatically turns off the image display after the predetermined period has elapsed.

7. The camera as claimed in claim 5 wherein the processing section erases the captured image prior to completion of the image processing.

8. The camera as claimed in claim 7 wherein the processing section responds to the erase command by terminating the processing of the image file and deleting the partially processed image file from the second memory.

9. (Twice Amended) An electronic still camera for capturing and displaying images, said camera comprising:

a shutter button for initiating capture of the images;

a sensor for capturing the images;

a first memory for storing a captured image;

an electronic image display for automatically displaying the captured images from the first memory for a first time interval in response to operation of said shutter button;

a second memory for storing a plurality of processed images; a processor for processing images from the first memory and storing the processed images as image files in the second memory, said processor operating over a second time interval to process an image; and

a user enabled control section coupled to the processor for erasing an image before the end of the second time interval so as to facilitate the capture and processing of another image.

10. The camera as claimed in claim 9 wherein the processor responds to the erase command by terminating the processing and deleting a partially completed image file from the second memory.

11. Canceled.

12. (Once Amended) The camera as claimed in claim 9 wherein the camera also includes an image display control section to enable the image display to be automatically turned off after displaying the captured image for the first time interval.

13. (Once Amended) A method for capturing and displaying an image with an electronic camera, said method comprising the steps of:

capturing an image in response to actuation of a shutter button;

storing the captured image in a buffer memory;

displaying the captured image in a processing section over a period of time, including the generation of a processed image file therefrom;

storing the processed image file in a second memory;



selectively enabling a quick view feature in which the image display is automatically turned on in response to actuation of the shutter button for a period of time after the image is captured in order to display the captured image stored in the first buffer memory, and then automatically turned off after the period has elapsed; and

providing an erase command to the processing section, which erases the captured image.

14. The method as claimed in claim 13 in which the captured image is erased prior to completion of the processing.

15. The method as claimed in claim 14 wherein the captured image is erased by terminating the processing of the image file and deleting the partially processed image file from the second memory.